

# Is It Too Soon to File for Trademark Registration?

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News headlines abound concerning the potential for normalizing trade relations with Cuba. U.S. companies that are likely to do business in Cuba, if and when trade restrictions are fully lifted, should take steps now to protect their trademarks in Cuba. Trademark rights are basically territorial in nature, and some countries (e.g., Brazil, China, Cuba) have first-to-file trademark priority systems, while others have first-to-use systems (e.g., Australia, Denmark, U.S.). In first-to-file countries, the first party to obtain a registration of the mark in that country is usually viewed as the owner of the mark in that country. Some first-to-file countries have exceptions for well-known marks that were first used in their country and/or first used in other countries but known in their country. While these exceptions can prove helpful, it is always more expensive for the rightful trademark owner to enforce its rights under the exceptions than to have first obtained the trademark registration in that country. Although the trade embargo with Cuba prevents companies in the U.S. from conducting business in Cuba and vice versa, the Cuban and U.S. governments allow companies in each country to obtain trademark registrations in the other's country. Because Cuba is a first-to-file country, **trademark owners are wise to promptly file applications for trademark registration in Cuba to avoid the possibility that Cuba will first issue a trademark registration to a party that is not the rightful trademark owner.** In such cases, the rightful trademark owner could face many problems in the Cuban market, including not being permitted to market and distribute its genuine products under its own trademark, and not being able to stop the unauthorized owner of the Cuban trademark registration from marketing and distributing products to customers in Cuba who believe they are being sold the genuine products of the rightful trademark owner. Brand owners may file applications for trademark registration in Cuba via a national application, or may qualify to obtain a trademark registration in Cuba pursuant to the Madrid Protocol by requesting an extension of protection of its international registration to Cuba. In addition to being the first to obtain trademark registrations in those countries where your company already conducts business and plans to conduct business within the next few years, trademark owners who wish to disrupt importations of counterfeits into the United States will promptly record their U.S. trademark registrations with U.S. Customs and Border Protection.

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